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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,677	12/04/2003	Yan Liu	R74.12-0001	8475

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EXAMINER

APANIUS, MICHAEL

ART UNIT	PAPER NUMBER
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3736

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/727,677	Applicant(s) LIU ET AL.	
	Examiner Michael Apanius	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006 and 30 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-10,15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/10/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendments filed on 7/10/2006 and 10/30/2006. The amendments are entered. The amendments to claims 1-6, 8-10, 15 and 16; the cancellation of claims 7 and 11-14; the replacement drawing sheets; and the substitute specification are acknowledged. Currently, claims 1-6, 8-10, 15 and 16 are pending.

Specification

2. The abstract of the disclosure is objected to because it contains several errors.

For example:

- a. At line 3 of the marked up copy of the substitute abstract, it appears that "he" should be --the--.
- b. At line 4 of the marked up copy of the substitute abstract, it appears that "bogy" should be --body--.
- c. At line 9 of the marked up copy of the substitute abstract, it appears that the line should end with a period instead of a semi-colon.
- d. At the last two lines of the marked up copy of the substitute abstract, the language includes legal phraseology.

Correction is required. See MPEP § 608.01(b).

3. The amendments are objected to under 35 U.S.C. 132(a) because they introduce new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall

Art Unit: 3736

introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- a. At page 1, first sentence of the substitute specification, the incorporation by reference is new matter since the original disclosure did not incorporate the foreign application by reference.
- b. At pages 2 and 3 of the marked up copy of the substitute specification, the added material describing other prior art is considered new matter.
- c. At page 7, lines 21-22 of the marked up copy of the substitute specification, the original disclosure does not sufficiently support that the weighing signal process circuit converts the signal from the weighing sensor into a frequency signal. Note that similar language has been added at other places in the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. The disclosure is objected to because numerous informalities remain in the substitute specification. For example:

- a. At page 1, line 6 from the bottom of the marked up copy of the substitute specification, the meaning of "druggery" is unclear.
- b. At page 2, line 14 of the marked up copy of the substitute specification, it appears that "the first" should be the beginning of a new sentence.
- c. At page 3, line 12 of the marked up copy of the substitute specification, it appears that "there are large error in those low-cost apparatus when use voltage" is incorrectly worded.

Art Unit: 3736

d. At the first line under the "Objects of the Invention" of the marked up copy of the substitute specification, it appears that "the object" should begin a new sentence.

e. At page 4, line 8 of the marked up copy of the substitute specification, it appears that "with barefoot" should simply be --barefoot--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-6, 8-10, 15 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 6 have been amended to recite that the signal coming from a weighing sensor is converted to a body weight frequency signal by a weighing signal processing circuit (i.e. see claim 1, lines 7-9 and 18-21; and see claim 6, lines 8-10). However, the original disclosure does not appear to support that the weighing signal processing circuit converts the signal into a body weight frequency signal. Therefore, the amended claims 1 and 6 introduce new matter into the application.

Art Unit: 3736

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-6, 8-10, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 contains numerous errors and inconsistencies that overall render the claim indefinite. For example, many limitations lack proper antecedent basis such as "the steps" (line 4), "the body weight frequency signal" (lines 8-9), "the oscillating frequency signals" (lines 9-10), and so on. Furthermore, some limitations are repeated such as the limitations of lines 7-9 and lines 18-21. The relation of some limitations to the rest of the claim language is unclear. For example, at lines 12-13, it is unclear what element is "connected to an MCU system".

10. Claim 6 contains several minor errors. For example, at line 5, it appears that "comprises a measuring platform, a electrode" should be --comprise a measuring platform, an electrode--. At line 23, it appears that "circuit, weighing" should be --circuit and weighing--. At lines 10, it appears that "the body weight frequency signal" lacks proper antecedent basis in the claim. Furthermore, the limitation at lines 19-22 is unclear. It does not appear that the electrode plate is connected as a two end impedance element (R_m) since according to figure 8, the test subject is the two end impedance element (R_m).

11. There are many other errors and inconsistencies in all of the pending claims that appear to require thorough revision.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida (EP 1,147,740) in view of Amerena (US 4,860,753). In regards to claim 6, Yoshida discloses a body composition monitor apparatus for measuring body impedance based on a method of frequency digital sampling, comprising a measuring unit (1) and a display unit (2), which above two units comprise a measuring platform (at 1), two groups of electrode plates (4a and 4b), a weighing sensor (15), a MCU system (21), a display (10) and a keyboard (11), wherein the apparatus includes a weighing signal processing circuit (16) that converts the signal coming from the weighing sensor to a body weight frequency signal, wherein the said monitor also includes an oscillator circuit (17) for measuring body impedance, wherein: the said electrode plates are connected with the oscillator circuit; the said oscillator circuit and weighing signal processing circuit are in electrical connection with a microprocessor. Yoshida does not expressly disclose a positive feedback RC oscillator circuit for measuring a dielectric constant of body tissue and capacitance grid sensors. Amerena teaches a positive feedback RC oscillator circuit (70; column 2, lines 4-7) for measuring dielectric constant of body tissue under the skin and capacitance grid sensors (figure 2) for the purpose of overcoming the disadvantages of impedance type measuring devices (column 1, lines 30-35). Note that

Art Unit: 3736

because the RC circuit is responsive to the capacitance of the electrode, or body tissue, it is a positive feedback circuit. Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to have used the positive feedback RC oscillator circuit and capacitance grid sensors as taught by Amerena in the apparatus of Yoshida in order to overcome the disadvantages of impedance type measuring devices such as variation in contact pressure and skin residues.

Allowable Subject Matter

14. Claims 1-5, 8-10, 15 and 16, as best understood, were previously indicated as containing allowable subject matter. However, it is noted that clarification of the claim language may require further search and consideration.

Response to Arguments

15. Applicant's arguments have been fully considered but they are not persuasive.

16. Applicant argues that claim 6, in contrast, states "a weighing signal processing circuit that converts the signal coming from the weighing sensor to the body weight frequency signal". In response, it is respectfully noted that Yoshida discloses a weighing signal processing circuit (16) as noted above that can be considered to meet a broadest, reasonable interpretation of "a weighing signal processing circuit that converts the signal coming from the weighing sensor to the body weight frequency signal".

17. Applicant further argues that "claim 6 includes measurement of 'body impedance' and not 'bioelectrical impedance'". In response, it is respectfully noted that "bioelectrical

Art Unit: 3736

impedance" can be considered a "body impedance" under a broadest, reasonable interpretation of the claim language.

18. In response to applicant's attempts to point out differences between the instant invention and the applied prior art, it is noted that the features upon which applicant relies (such as an A/D converter not being necessary or that Yoshida and Amerena need 4 or 3 electrode dependence on each other) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


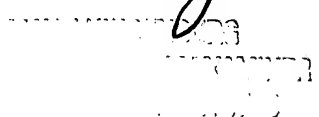
Art Unit: 3736

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Apanius whose telephone number is (571) 272-5537. The examiner can normally be reached on Mon-Fri 8am-4:30pm.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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